

Attorney Docket No. P64053US0
Serial No. 09/423,665

Remarks/Arguments:

Claims 47, 50, 51, 53, 55, 57, 59, 61-63, and 71, currently amended, claims 48, 49, 52, 54, 56, 60, 64-70, and 72, previously presented, and claim 73, newly presented hereby, are pending.

Claims 1-46 and 58 are cancelled, without prejudice or disclaimer.

New claim 73 contains the subject matter of claim 46 (which it replaces as a generic claim), rewritten to more clearly define the instant invention, in particular to include and inherent feature of the "anethol" component of the presently claimed beverage. Claim 71 is similarly amended, hereby. As described throughout the subject application (e.g., page 1, lines 30-37, page 2, lines 18-21 and 28-33), the presently claimed invention combines a phospholipid with the compound anethol (*methyl ether of para-propenyl phenol* [$C_6H_4.C_3H_5.OCH_3$]), in order to increase the anethol concentration in non-aqueous anethol-containing beverages, without adversely affecting the clarity of the beverages and the ability of the beverages to become cloudy when combined with water. Accordingly, application Figure 1 contains the solubility curve of anethol in alcohol at various alcohol concentrations (at 20 °C). In other words, the presently claimed invention uses anethol, itself, i.e., isolated anethol. Thus, to more clearly define the invention, claims 71 and 73 recite that the anethol compound, itself, i.e., "isolated anethol," is used in accordance with the presently claimed invention, as inherently described in the subject application as originally filed. Commensurately, claims 47, 50, 51, 53, 55, 57, 59, and 61-63 are amended, hereby, to be dependent on claim 73.

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Claims 46-72 were rejected under 35 USC 112, 2nd ¶, as allegedly being indefinite. Reconsideration is requested.

According to the statement of rejection, reciting "an effective amount" of the "phospholipid" component in (apparently) claims 46 and 71 (the statement of rejection indicates "claims 1 and 70," but claim 1 was canceled and "an effective amount" is not found in claim 70) is indefinite because, allegedly, "it is not clear what this amount is or what it is meant to be effective in doing" (Office Action, page 2). The statement of rejection is mistaken.

The claim limitation "an effective amount of at least one phospholipid " is explicitly defined in the present specification (page 2, lines 28-36), i.e.:

The invention therefore first provides a beverage optionally alcoholic containing anethol, characterized in that it comprises an effective amount of at least one phospholipid which is acceptable in human food, in order to improve the solubility of anethol in said beverage.

By "effective" amount is meant an amount sufficient to reduce the turbidity of nonalcoholic or slightly alcoholic beverages containing anethol.

The Examiner's definition of a claim limitation cannot conflict with the definition given in the specification. *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), which must be used in construing the claims for purposes of examination.

When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.

Zletz, 13 USPQ2d at 1322. Accordingly, the rejection under §112, ¶2, appears to be in order for withdrawal.

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Claim 46-71 were rejected under 35 USC 102(b) as allegedly anticipated by US4835002 (Wolf), as allegedly evidenced by *The Dispensatory of the United States of America*, edited by Joseph P. Remington, Horatio C. Wood and others, 1918, "Oleum Anisi. U. S., Br., Oil of Anise. Ol. Anisi [Anise Oil]" ("US Dispensatory") and Wikipedia. Reconsideration is requested.

For anticipation under §102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically appear*" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

The present claims provide a beverage product (alcoholic or non-alcoholic) that broadly contains "isolated anethol" combined with a suitable phospholipid in a submicron emulsion or microemulsion (claim 71) and further combined with a substance that, when water is added to the beverage, destabilizes the emulsion (claim 73). The beverage product "is clear" (claims 50 and 71), and it becomes cloudy when an acidic liquid or water is added, because the emulsion is destabilized (claims 57, 58, and 71).

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A salient distinction between the presently claimed invention and Wolf is that the instant invention uses anethol, itself, i.e., pure (isolated) anethol; whereas, on the other hand, Wolf does not. Instead of pure anethol, Wolf uses an anethol containing plant extract, i.e., anise oil. In other words, a limitation on the present claims—"isolated anethol"—is not found in Wolf. This is readily apparent from the teachings of US Dispensatory, relied on to reject the claims.

According to the US Dispensatory "anethol" is the compound "methyl ether of para-propenyl phenol [$C_6H_4.C_3H_5.OCH_3$]." On the other hand, according to the US Dispensatory "anise oil," while containing mostly anethol, contains other compounds as well, e.g., star anise oil "contains besides anethol, pinene and phellandrene."

According to the US Dispensatory anethol, itself, "forms of clear solution with two volumes of alcohol." On the other hand, according to the US Dispensatory anise oil "is soluble in all proportions of alcohol of 0.806; but alcohol of 0.840 dissolves at 25°C. (77°F.) only 42 percent."

According to the US Dispensatory anethol is a "liquid at a temperature of 23° C. (73.4° F.) or above . . . [and] At from 20° to 21° C. (68°-69.8° F.) it solidifies to a white, glistening, crystalline mass which remelts at from 22° to 23° C. (71.6°-73.4° F.)." On the other hand, according to the US Dispensatory anise oil "crystallizes" at "10°C. (50°F.) . . . and it does not melt under 16.6°C."

Since a limitation on the present claims—"isolated anethol"—is absent from Wolf, anticipation based on Wolff is negated. *Kolster Speedsteel A B, supra*. Wolf cannot anticipate the present claims, because "isolated anethol" (appearing in the present claims) is not *identical* to the anethol-containing anise oil appearing in Wolff. *Gechter, supra*. Accordingly, withdrawal of the

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rejection for alleged anticipation under §102(b) based on Wolff appears to be in order for withdrawal.

Moreover, Wolf fails to meet the standards necessary to constitute an anticipatory reference under §102(b). For anticipation under §102(b) to exist, each and every claim limitation, *as arranged in the claim*, must be found in a single prior art reference. *Jamesbury Corp., supra.*

Wolf discloses "microemulsions of edible oils in a matrix of water and certain alcohols with the aid of certain surfactants" (Wolf, column 1, lines 8-10) (emphasis added). According to Wolf (column 2, lines 50-53), the "edible oils which are to be used . . . include all those natural edible oils normally extracted, as such, from their plant matter or animal source."

In the entire disclosure of Wolf "anise oil" can be found only once. Moreover, the single occurrence is found in a list containing no fewer than 45 other useful edible oils useful (Wolf, column 3, lines 1-44). Needless to say, therefore, neither a single arrangement of anise oil (as edible oil) and an alcohol, together, nor a single arrangement of anise oil (as edible oil), a phospholipid (as surfactant), and an alcohol, together, can be found in Wolf.

Since Wolf fails to disclose even anise oil—let alone anethol, itself—as arranged in the present claims, i.e., either together with an alcohol (claims 71 and 72) or together with an alcohol and a phospholipid (claims 47-70 and 73), anticipation of the present claims by Wolf, under §102(b), cannot exist. *Jamesbury Corp., supra.* Accordingly, withdrawal of the rejection appears, further, to be in order.

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***Repeated Request for Acknowledgment of
Foreign Priority Under 35 USC 119***

Applicant repeats her Request for Acknowledgment of Foreign Priority Under 35 USC 119, filed January 24, 2005. Neither the instant Office Action, nor any other paper, has even acknowledged the original request, let alone granted §119 priority on the record, as requested.

As set forth in the original request, the claim to foreign priority under 35 USC 119 was made in the inventorship declaration of record, and the certified copy of the priority document (the "priority document") was received by the PTO, as evidenced by the Notification of Acceptance of record, mailed January 20, 2000, by the PTO, and the Form PCT/IB304 of record, mailed 21 April 1999 by the International Bureau.


Accordingly, request is made, again, that the Examiner mark the next Office Action to acknowledge, both, the claim to §119 priority and receipt of the priority document.

Favorable action is requested.

Respectfully submitted,

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